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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/710,308

07/01/2004

David S. Bonalle

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EXAMINER

WALSH, DANIEL I

ART UNIT

PAPER NUMBER

2876

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Please find below and/or attached an Office communication concerning this application or proceeding.

A.D

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/710,308		BONALLE ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Daniel I. Walsh		2876	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7-04, 8-04</u> . | 6) <input type="checkbox"/> Other: ____.  |

### DETAILED ACTION

1. Receipt is acknowledged of the IDS of 1 July 2004 and 5 August 2004.

#### *Double Patenting*

2. Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22-24, 26-29, and 33-34 of copending Application No. 10/710,310, and 10/710,311.

Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 23-30 and 33-34 of copending Application No. 10/710,315, 10/710,326, 10/710,328, and 10/710,329.

Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22-24, 26-29, and 32-33 of copending Application No. 10/710,317, 10/710,323, 10/710,324, 10/710,325, and 10/710,327.

Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 24-26, 28-31, and 34-35 of copending Application No. 10/710,319.

Claims 1, 6, 7, and 9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 10, and 19 of copending Application No. 10/710,307.

Claims 1, 6, and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7, and 6 of copending Application No. 10/710,309.

Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22-24, 26-29, and 33-34 of copending Application No. 10/708,825 and 10/708,826.

Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 23-25, 27-30, and 33-34 of copending Application No. 10/708,827, 10/708,833, 10/708,835, and 10/708,836.

Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22-24, 26-29, and 32-33 of copending Application No. 10/708,828, 10/708,830, 10/708,831, 10/708,832, and 10/708,834.

Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 24-26, 28-31, and 34-35 of copending Application No. 10/708,828.

Claims 1 and 6-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 10, 14, and 19 of copending Application No. 10/708,822.

Claims 1 and 6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7 of copending Application No. 10/708,824.

3. Although the conflicting claims are not identical, they are not patentably distinct from each other because the Applications all deal with verifying a biometric to authorize a transaction, though some may include specific types of biometrics, such biometrics are well known and conventional in the art, and the '307 Patent Application is a broader recitation of a biometric, in these instances.

For instance:

In claim 1 of the present claimed invention and claim 22 of the '310 Patent Application the Applicants claim:

i) "...smartcard transaction system... proffering a biometric ...verification...authorization of a transaction." (see claim 1), whereas in the '310 Patent Application the Applicants claim "...smartcard transaction system...fingerprint...authorization for a transaction." (see claim 22). The Examiner notes that a fingerprint is a type of biometric.

In claim 2 of the present claimed invention and claim 23 of the '310 Patent Application the Applicants claim:

ii) "...authorized sample receiver." (see claim 2), whereas in the '310 Patent Application the Applicants claim "...authorized sample receiver." (see claim 23).

In claim 3 of the present claimed invention and claim 24 of the '310 Patent Application the Applicants claim:

iii) "...registering...verifying...upon verification.." (see claim 3), whereas in the '310 Patent Application the Applicants claim "...registering...verifying...upon verification.." (see claim 24).

In claim 4 of the present claimed invention and claim 26 of the '310 Patent Application the Applicants claim:

iv) "...initiate at least one of...verifying said biometric sample" (see claim 4), whereas in the in '310 Patent Application the Applicants claim "...initiate at least one of...verifying said fingerprint sample" (see claim 26).

In claim 5 of the present claimed invention and claim 27 of the '310 Patent Application the Applicants claim:

v) "...initiate verification...smartcard system." (see claim 5), whereas in the '310 Patent Application the Applicants claim "...initiate verification...smartcard system." (see claim 27).

In claim 6 of the present claimed invention and claim 28 of the '310 Patent Application the Applicants claim:

vi) "...comparing a proffered biometric...with a stored biometric..." (see claim 6), whereas in the '310 Patent Application the Applicants claim "...comparing a proffered fingerprint....stored fingerprint..." (see claim 28).

In claim 7 of the present claimed invention and claim 29 of the '310 Patent Application the Applicants claim:

vii) "...comparing...local CPU." (see claim 7), whereas in the '310 Patent Application the Applicants claim "...comparing...local CPU." (see claim 29).

In claim 8 of the present claimed invention and claim 33 of the '310 Patent Application, the Applicants claim:

viii) "...storing at least one second proffered biometric sample." (see claim 8), whereas in the '310 Patent Application the Applicants claim "...storing at least one second proffered fingerprint sample." (see claim 33).

In claim 9 of the present claimed invention and claim 34 of the '310 Patent Application the Applicants claim:

ix) "...secondary security procedure." (see claim 9), whereas in the '310 Patent Application the Applicants claim "...secondary security procedure." (see claim 44).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Re the additional Applications listed above, the Examiner notes that they are rejected in the same manner as discussed above with regard to the '311 Patent Application, as they all merely recite obvious types of biometrics and obvious variations used in the verification of smartcard transactions. The 10/708,xxx series of patent applications, though drawn to a transponder and not a smartcard, are also rejected in the same manner. The Examiner notes that



the use of a transponder in place of smart card is obvious to one of ordinary skill in the art (see teachings of Black below, which recite either a transponder, card, or other type of wireless device maybe used to facilitate biometric verification for a transaction, as is conventional in the art.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 4, 6, 8, 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Black (US 2005/0122209).

Re claim 1 Black teaches a method for facilitating biometric security in a smartcard transaction system comprising: proffering a biometric to a biometric sensor communicating with said system to initiate verification of a biometric sample for facilitating authorization of a transaction (abstract, FIG. 1C).

Re claim 2, Black teaches registering at least one biometric sample with an authorized sample receiver (abstract, FIG. 5A). The sample receiver of the invention is interpreted as an authorized sample receiver.



Re claim 4, Black teaches the step of proffering includes proffering a biometric to a biometric sensor communicating with the system to initiate at least one of storing, comparing and verifying the biometric sample (abstract).

Re claim 6, Black teaches that the step of proffering a biometric to a biometric sensor communicating with the system to initiate verification further includes comparing a proffered biometric sample with a stored biometric sample (abstract, which teaches comparing the sample to reference data/samples).

Re claim 8, Black teaches proffering includes at least one of detecting, processing , and storing at least one second biometric sample (abstract, which teaches a electronic and digital signature). The Examiner notes that a electronic signature is consistent with the definition of a biometric as supplied in the Applicants own specification.

Re claim 9, the Examiner notes that the electronic signature and metrics (abstract, FIG. 1C) are interpreted as a secondary security procedure. The Examiner also notes that PINs are also a well-known and conventional secondary security procedure for increasing security.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was

commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 3, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black.

Re claim 3, Black teaches that registering includes at least one of: contacting the authorized sample receiver, proffering a biometric to the authorized sample receiver, processing the biometric to obtain a biometric sample, associating the biometric sample with user information, verifying the biometric sample, and storing the biometric sample upon verification (abstract, FIG. 10A-11B, FIG. 5A, etc.). Though Black teaches a transponder, the Examiner notes that Black teaches the device can be a card, smartcard, etc. (abstract). Accordingly, it is obvious to the Examiner that registration procedures apply when a smartcard is used.

Re claim 5, Black teaches the step of proffering a biometric to a biometric sensor communicating with the system to initiate verification further includes processing database information, wherein the database information is contained in at least one of a smartcard, smartcard reader, sensor, remote server, merchant server, and smartcard system (paragraph [0125], FIG. 10A-11B and 14A-14B) which teaches information stored on the host computer.

The Examiner notes that though such information is shown with reference to an RFID/transponder, that it has been discussed above that such teachings can apply to smartcards to produce expected results. Additionally, the Examiner notes that Black teaches that the information can be stored on the transponder/card itself or remotely, depending on security

(paragraph [0090]+). Though silent to a database, the Examiner notes it is an obvious expedient to store accessible data in a database format for ease and convenience of retrieval and processing, as is known in the art. Accordingly, the Examiner notes it would have been obvious to process database information contained either in the card, or remotely, to verify the information (biometric) to facilitate a transaction.

Re claim 7, as Black teaches a card reader processor (FIG. 1A, FIG. 1B, 1C) in communication with the host computer, it is understood that the card reader processor is used to compare the samples (see claim 1 of Black). Again, though the different embodiments show Black with a transponder and that local processor performs comparison, as discussed above, such teachings can be applied to smartcards/other portable devices, to authenticate a biometric sample for a transaction, as discussed above. Accordingly, such modification is an obvious expedient, well within the skill in the art.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Gokcebay (US 5,245,329), Dolphin (US 5,677,953), Meadows et al. (US 5,869,822), Dunn et al. (US 5,987,155), Gray (US 6,268,788), Pare et al. (US 6,269,348), Takhar (US 2001/0053239), Iannacci (US 2002/0062249), Kawan (US 2002/0062284), Segal et al. (US 2002/0066784), Doyle et al. (US 2002/0095587), Janiak et al. (US 2002/0097142), Prokoski et al. (US 2002/0140542), Wang et al. (US 2002/0163421), Gravelle et al. (US 2002/178063), Simon (US 2003/0086591), Seifert (US 2003/0112120), Mitchell et al. (US 2003/0149661), Joseph (US 2003/0150911), Palmer et al. (US 2003/0266041), McCall et al. (US 2003/0229793),

Hoffman et al. (US 2004/0020982), Koo (US 2004/0021552), Nugent (US 2004/0041021), Yamagishi (US 2004/0041690), Deyoe et al. (US 2004/0084542), Machida (US 2004/0131237), Doughty et al. (US 2004/0133787), Zuili (US 2004/0149827), Royer et al. (US 2004/0155101), Lee (US 2004/0195314), Barillova et al. (US 2004/0199469), Golden et al. (US 2004/0208343), Kotzin (US 2004/0257196), Doughty et al (US 2005/0001711), Haala (US 2005/0005172), Ikeda et al. (US 2005/0018658), Inabe (US 2005/0033992), Rothschild et al. (US 2005/0054438), Gotfried et al. (US 2005/0087597), Kuwana et al. (US 2005/0091325), Haala (US 2005/0102524), Moebs (US 2005/0065872), Maritzen et al. (US 2002/0191816), Goodman et al. (US 2002/0043566), and Arnouse (US 2005/0139669).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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D. Walsh



Daniel I Walsh

Examiner

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7-21-05

Daniel Walsh